

Section III:
AMENDMENT UNDER 37 CFR §1.121 to the
DRAWINGS

No amendments or changes to the Drawings are proposed.

Section IV:
AMENDMENT UNDER 37 CFR §1.121
REMARKS

Cross-Noting to Examination of Related Patent Applications

The present patent application is related to several co-pending applications. Applicants submit herewith a supplemental Information Disclosure Statement containing relevant references from these related cases. Through submission of this IDS, Applicants are not agreeing that any material submitted is prior art.

Certain aspects of the amendment made herein are directed towards distinctive features not taught by the submitted items. Examiners of the related cases have been interviewed with respect to these amendment aspects, and all have agreed informally that the amendments distinguish over the cited references in those cases, pending an update to their respective searches.

Applicants request the Examiner of the present application to contact their agent, Robert Frantz, at 405-812-5613 if the Examiner has any questions or suggestions regarding these additional references and the distinctive aspects of the present amendment.

Response to Examiner's Note

In the Office Action, it was noted that certain claims used phrases "for <active verb>" and "adapted to <active verb>", which the Office does not consider to impart patentable weight. Applicants do not object to replacement of such phrases with the Office's preference of "configured to <active verb>". Claims 9, 10, and 12 have been amended accordingly.

Double Patenting Rejections

In the Office Action, Claims 1, 5 and 9 were provisionally rejected under judicially-established doctrine of obviousness-type double patent prohibition over co-assigned, co-pending patent application serial number 10/865,347.

Applicants respectfully disagree with the holding of obviousness between the co-pending claims. The side-by-side comparison of example claims is incomplete whereas steps which are not similar have been omitted, which Applicants respectfully submit fails to consider the points

of difference and fails to consider the claims as a whole, leaving the claims to appear to be different from each other only in wording choices.

However, the omitted steps amount to non-obvious differences between the two claimed inventions. While it may seem that one set of claims (i.e. the earlier filed claims of the present application) would dominate or possibly encompass the second set of claims (i.e. the later filed claims of the co-pending application), applicants submit that the required two-way obviousness test would not be satisfied as required of co-pending claims, and thus the rejections would be improper¹.

In the following side-by-side comparison of the claims, all claim steps have been compared without omission of any non-similar steps, with emphasis added for ease of comparison. The state of the claims shown in the following table reflects the claims as filed, and does not reflect additional distinctive features as a result of the amendment made herein.

Applicants respectfully submit that the individual step differences impart non-obvious distinction from each other, and the claims considered as a whole are non-obvious with respect to each other.

¹ *Carman Industries, Inc., v. Wahl*, 724 F.2d 932, 220 USPQ 481 (Fed. Cir. 1983). See also *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991).

Claim 1 compared to Claim 12 of Co-pending Application (as filed)

| <u>Present Application</u> | <u>Co-Pending 10/755,832</u> | <u>Comparison Notes</u> |
|---|---|--|
| 1. A method for transferring <u>content</u> from one computer resource to another computer resource, comprising the steps of: | 12. A method for transferring computer-readable <u>image</u> content from one computer resource to another computer resource, comprising the steps of: | present application claims the broader handling of "content", while the co-pending application is directed towards image processing only (e.g. image content does not directly contain text data such as ASCII or ANSI text data, whereas non-image content may include text data, audio data, etc.) |
| intercepting the transfer of one or more <u>information elements</u> selected from a source to a destination; | intercepting the transfer of a source <u>image element</u> from a computer-readable source to a computer-readable destination; | present application claims broader "information element", but co-pending application claims only "image element" |
| | recognizing one or more embedded text instances within each said intercepted source image element; | present application claim does not recite optical recognition of text within the image element being transferred, and there is no suggestion in the present disclosure to do so, thus the co-pending application's claim is non-obvious relative to the earlier-filed present application |
| determining if each intercepted information element is expressed in a natural language which matches a user-specified natural language; | determining if each embedded text instance is expressed in a natural language which matches a user-specified destination natural language; | same step in both claims because the text in both situations has been reduced to text data (e.g. the image of text has been converted to binary, ASCII, etc., text) |
| performing one or more natural language handling actions on information elements which do not match said user specified natural language as defined by one or more natural language handling rules; and | performing natural language translation of one or more embedded text instances which do not match said user specified destination natural language; | similar steps in both claims |

| | | |
|--|--|--|
| | <u>rendering translated text data for each translated text instance;</u> | present application claim does not have this step to render the translated text (e.g. binary, ASCII, etc.) into image data |
| | <u>producing a modified computer-readable image element by replacing each embedded text instance with corresponding translated embedded text image; and</u> | present application claim does not have this step to produce a composite image by replacing the image of the original text with the image of the translated text |
| transferring any information elements to said destination which have been translated to said user specified natural language as a result of said handling actions. | transferring said modified image element to said computer readable destination. | similar step in both claims |

As such, it is evident that the later-filed claims are directed towards non-obvious work which is a derivative of, but not an obvious variant of, the earlier filed claims. There is no suggestion in the earlier filed disclosure to enhance or modify the invention of the present application to recognize images of text within an image, optically recognize that image to render text data, translate the text data to another NLS if necessary, convert the translated text back to image data, and then to merge that new image data with the original image to replace the image of the original text.

A similar, complete comparison of the independent system claim (present 5 to co-pending 22) and computer-readable medium claim (present 9 to co-pending 1) of both applications yields the same points of difference between the claims.

For these reasons, Applicants respectfully request withdrawal of the provisional obviousness-type double patenting rejections of claims 1, 5, and 9, whereas the claims must be consider as a whole as well as in their parts, and whereas a two-way obviousness test must be satisfied when neither set of claims has issued as a patent yet.

Rejections under 35 U.S.C. §101

In the Office Action, Claims 1, 5, and 9 - 14 were rejected under 35 U.S.C. §101 for being directed to non-statutory matter.

With respect to the raised question regarding claims 1 and 5 whether or not a concrete, useful, and tangible result is produced, both claims produce information elements having translated natural language in them. By "natural language", the claims are referring to a human spoken or written language, such as English, Japanese, Spanish, Farsi, etc. (see para. 0037). Such a natural language is "tangible" in that it can be read or heard by a human. By "information elements", the claims are referring to text, tables, graphics, hyperlinks, etc., which are computer readable (see para. 0091). As such, the claimed step:

" . . . determining if each intercepted information element is expressed in a natural language which matches a user-specified natural language;"

by definition selects only information elements which are both human readable and computer readable. Then, the claimed steps:

" . . . performing one or more natural language handling actions on information elements which do not match said user specified natural language as defined by one or more natural language handling rules; and
transferring any information elements to said destination which have been translated to said user specified natural language as a result of said handling actions."

by definition modify those human-readable and computer-readable information elements. There is no disclosure (or claim step) which suggests the modifications in any way remove the human-readable aspects of the information element, only the human readable portion is translated to another human readable format (i.e. from one natural language to another natural language). Therefore, the result or product of the claimed steps is both machine readable and human readable, which is heard or seen through a computer platform's display or speaker (see

paras. 0051, 0054, and 0055), and as such, the product of the claims is tangible, useful and concrete.

With respect to the statement that "since the translating step only performs . . . furthermore, the transferring step transfers only the translated information", Applicants are only required to claim the invention, but the claims (taken alone) are required only to recite enough features, steps, and elements to set forth an operable embodiment with patentably distinctions. The specification is required to teach a preferred embodiment. As such, examiner's point that only the translated elements are transferred to the destination is presumably directed to those elements which are not translated - what happens to them? In one possible embodiment they are transferred unmodified to the destination (see #63 of Fig. 6). But, this step is not claimed in the broadest claims because it is not part of the minimum configuration of the invention (e.g. transferring unmodified information is not new, and simply checking data for compatibility without taking any action or transforming the information element would not seem to meet the requirements of §101).

With respect to the argument that claims 9 - 14 could be interpreted by one of ordinary skill as software, per se, and that Applicants' specification provides no explicit and deliberate definition of the system components recited in this claim, Applicants respectfully disagree. By "system", Applicants are referring to a combination of software and hardware, or even an embodiment purely in hardware (e.g. electronic circuitry and mechanical devices). Such a "system" was thoroughly described, including many recitations of circuitry and hardware components, in the "suitable computing platform" portion of the detailed description (see paras. 0044 - 0064). And, logical processes were described in an interchangeable manner as method steps or "system functions" in alternative embodiments (see paras. 0002 - 0004, 0069).

More specifically, Applicants stated at the outset of the description of the "logical processes" that (see para. 0065):

"It will be readily recognized by those skilled in the art that the following methods and processes may be alternatively realized as hardware functions, in part or in whole, without departing from the spirit and scope of the invention."

As such, Applicants respectfully submit that one of ordinary skill in the art, equipped

with both the claims and the complete specification, would readily recognize that an "an information transfer interceptor configured to intercept one or more information elements in transit from a source to a destination via a transfer buffer . . . " claims a system component corresponding to the logical process described as "intercepting one or more information elements". The same person would also recognize such a system component could be realized in custom circuitry, such as an Application Specific Integrated Circuit ("ASIC"), a programmed processor, etc.

Further, the recitation of the claim as a "system" in the context of an invention described for embodiment in conjunction with a "suitable computer platform" invokes the ordinary definition² which necessarily includes more than just software:

system - *noun*

. . .

15. *Computers.* a working combination of hardware, software, and data communications devices.

. . .

For these reasons, claims 9 - 14 do not only recite software, per se.

Rejections under 35 U.S.C. §112

In the Office Action, claims 1 and 5 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite with respect to recitation of an "if" phrase or condition.

Applicants amend these claims herein to recite

" . . . determining [[if each]] which intercepted information ~~element is~~ elements are expressed in a natural language ~~which matches~~ not matching a user-specified natural language;

performing one or more natural language handling actions on information said elements which do not match said user specified natural language as defined by one or more natural language handling rules; and . . . "

² "system." *Dictionary.com Unabridged (v 1.1)*. Random House, Inc. 05 Jun. 2007.

<Dictionary.com <http://dictionary.reference.com/browse/system>>.

Replacement of "if each . . . " with the phrase "which . . . elements are" removes the possible confusion of a conditional phrase, and addition of "said" prior to "elements" clearly refers back to the unmatched elements.

Rejections under 35 U.S.C. §102(b)

In the Office Action, claims 1, 2, 5, 6, 9, 10, and 12 - 14 were rejected under 35 U.S.C. §102(b) for lack of novelty as being anticipated by U.S. Patent Number 5,974,372 to Barnes (hereinafter "Barnes").

The present invention is directed towards operations within an improved process of "cutting and pasting" information from one electronic document (e.g. our computer resource), and another electronic document. Applicants have amended claims 1, 5 and 9 to specifically recite that "computer resource" is referring to an electronic document. Barnes, however, fails to teach cutting and pasting between electronic documents, but instead teaches interception of user interface screen information sourced from an application program destined for a computer screen. Neither an application program nor a computer screen is an electronic document.

The present invention is also directed towards a cutting-and-pasting operation which is reversed of the traditional document-to-document process. Normally, a user selects the source information first from a first user interface (e.g. a first window), then navigates to a second user interface (e.g. a second window) to designate the destination insertion point. This can be characterized as a source-first, destination-second process. The present invention is directed towards a destination-first, source-second process, and the claims are amended herein to specify the temporal relationship between the steps and elements of the invention. Barnes, however, does not teach a user having a destination choice, whereas the destination is fixed (i.e. the destination is always a screen).

Given these points of distinction untaught by Barnes, Applicants respectfully submit that claims 1, 2, 5, 6, 9, 10, and 12 - 14 are in condition for allowance.

Rejections under 35 U.S.C. §103

In the Office Action, claims 3, 4, 7, 8, and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Barnes alone. Barnes alone fails to teach the steps, element, and limitations as discussed in the foregoing paragraphs regarding the independent claims from

which these claims depend.

Further, with respect to the rationale for rejection of claims 3, 7 and 11, Applicants respectfully disagree that it would have been obvious to modify Barnes to automatically determine if the selected source information is in a natural language designated by the user, and respectfully disagree that motivation to do so is found in Barnes' disclosure.

Regarding the proposed modification itself, Barnes has no need to recognize the natural language of their application program output because this act has already been performed during the manual population of their translation table. Thus, the Barnes invention must only check to see if an intercepted screen output is registered (e.g. "hooked" in Barnes' terminology) in their translation table. There is no suggestion in the Barnes disclosure of how, or why, one would replace their "hook" checking step and their translation table as needed to anticipate Applicants' claimed step or element which determines the selected information's natural language.

Regarding motivation, this modification is not necessary for Barnes' system to achieve their stated objective to intercept and replace application program screen output because it is reasonable to believe that the designer of the application program already would know the natural language in which the original screens are presented. Thus, there is only a need by Barnes to populate their translation table accordingly. Barnes' fails to recognize the need to process user selections of information which may be in an unknown natural language, and thus there can be no motivation provided by Barnes disclosure to make the proposed modification.

Regarding the rationale for rejection of Claim 4 and 8, Applicants respectfully disagree that Barnes' invoked screen to input "certain data" (col. 4 line 7) is the same as Applicants' disclosed and claimed "handling rules". Barnes' "certain data" appears to be information regarding the characteristics of the input data (double byte or single byte characters, right-to-left or left-to-right reading order, etc.). The action for Barnes, however, is always the same (i.e. intercept, checking "hooking" into table, exchange data with table translation, display exchanged data). Applicants' handling rules enable or disable many other actions, such as whether or not source information is concatenated with the information already in the transfer buffer or if it over-writes the information in the transfer buffer, whether or not the source information is "cut" (i.e. deleted) from the source automatically, etc. (see para. 0071, for example).

Conclusion

Applicants respectfully request entry of the amendment, consideration of the foregoing remarks, consideration of the items submitted herewith in an supplemental Information Disclosure Statement, and allowance of the claims.

Respectfully,

/ Robert Frantz /

Robert H. Frantz, Reg. No. 42,553
Agent for Applicants
Tel: (405) 812-5613
Franklin Gray Patents, LLC